

REMARKS**I. Status of Claims**

Claims 1-4, 8-51, and 57-63 are currently pending. Claims 5-7 and 52-56 are canceled herein without prejudice or disclaimer. Claims 1, 59, 62, and 63 are amended herein to recite that the ratio of the at least one binder A to the at least one particulate phase B ranges from 1:1 to 2.5:1. Support for this amendment can be found in the specification and claims as originally filed, for example, original claim 7. Claim 51 is amended to reflect the scope of amended claim 1 from which it depends. Accordingly, no new matter is introduced by this amendment.

II. Rejections Under 35 U.S.C. § 103(a)

Claims 1-63 remain rejected as allegedly unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 6,403,704 to Bara ("the '704 patent"), U.S. Patent No. 6,689,345 to Jager-Lezer ("the '345 patent"), U.S. Patent No. 6,565,862 to Bara ("the '862 patent"), or U.S. Patent No. 7,094,842 to Lennon ("the '842 patent"). See Office Action at 3-5. The Examiner newly rejected claims 1-63 under 35 U.S.C. § 103 as allegedly unpatentable over European Patent No. 1 064 930 to Jager-Lezer ("EP '930) or Japanese Patent Application Publication No. 2000-103717 assigned to Mura et al. ("JP '717") in view of EP '930. Applicants respectfully traverse these rejections for at least the following reasons.

The '842 patent

As a preliminary matter, Applicants note that the Examiner previously withdrew the rejection under 35 U.S.C. § 103 over the '842 patent. See Office Action dated

September 17, 2007, at 5. Additionally, Applicants note that the Examiner did not address the '842 patent in detail in the instant Office Action. Accordingly, Applicants believe that the listing of the '842 patent in the rejection on page 5 of the instant Office Action is in error. If Applicants are mistaken, and the Examiner wishes to reinstate the rejection of the claims under 35 U.S.C. § 103 over the '842 patent, Applicants respectfully request clarification and explanation of the rejection.

The '704, '862, and '345 patents

The Examiner argues that, while the '704, '862, and '345 patents do not teach the claimed ratios of organopolysiloxane to particulate phase (see, e.g., claim 1), these patents "teach all of the components claimed and also desire the claimed texture of the make up composition and therefore optimizing the individual components so as to arrive at the claimed texture, i.e., a paste or a powder, would have been within the scope of a skilled artisan, with a reasonable expectation of success." Office Action at 10. Applicants respectfully disagree.

As disclosed in the specification, as recited in the presently pending claims, and as discussed in detail in the Submission filed March 17, 2008 ("the Submission"), which remarks are incorporated herein by reference, the instant invention relates to compositions having a pulverulent-to-pasty texture, which is imparted by the claimed ratio of binder A to particulate phase B ("A/B ratio") and the claimed ratio of organopolysiloxane C to particulate phase B ("C/B ratio"). While the '704, '862, and '345 patents do teach foundations and eye shadows, none of these references teach or suggest the desirability of a composition having such a pulverulent-to-pasty texture, much less the A/B and C/B ratios required to achieve such a texture. Without any

specific guidance from these references, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '704, '862, and '345 patents by picking and choosing the particular claimed ranges of A/B and C/B ratios to achieve the present invention, as alleged by the Examiner.

Indeed, as set forth in detail in the Submission (*see, e.g.*, Table I), the '704, '862, and '345 patents teach such widely varying concentrations (and, thus, ratios) of organopolysiloxane and particulate phase, it cannot reasonably be said that the disclosures of these references provide any motivation to optimize the A/B and C/B ratios to arrive at the claimed invention. In addition, as laid out in detail in the Submission (*see, e.g.*, Table II), each of the relevant examples provided in the '704, '862, and '345 patents teach organopolysiloxane C to particulate phase B ratios falling outside of the claimed C/B ratio. Thus, the only specific guidance provided by these references, does not lead the skilled artisan to the claimed invention; rather, that specific guidance leads the artisan away from the claimed invention.

As such, it cannot be said that the disclosures of these patents would motivate one skilled in the art to "optimize" the compositions of the patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention. For at least these reasons, the Examiner has not established a *prima facie* case of obviousness and Applicants respectfully request that the rejections over the '704, '862, and '345 patents be withdrawn.

The Examiner further states that "[w]hile applicants state that the ratios of the references are outside the claimed range, they do not provide any comparative results showing that the prior art patents do not result in a paste or a powdery texture and that

there is no reasonable expectation of success within the disclosed concentrations of organopolysiloxane and the particulate phase in the prior art." Office Action at 5. In direct response to the Examiner's statement, Applicants submit herewith the Declaration under 37 C.F.R. § 1.132 of Marie-Laure DELACOUR ("the Declaration"). This Declaration is submitted as evidence that compositions having the claimed A/B and C/B ratios possess a pulverulent-to-pasty texture, while compositions falling outside the claimed A/B and C/B ratios do not.

In her Declaration, Ms. DELACOUR describes the preparation and analysis of inventive Compositions 1 and 4, having A/B and C/B ratios in accordance with the presently pending claims. Inventive Compositions 1 and 4 were compared with Compositions 2 and 3, which fall outside of the scope of the pending claims. The results indicated that inventive Compositions 1 and 4 provided improved texture, cohesion, and deformability, as compared to Compositions 2 and 3.

The Declaration compares the claimed subject matter with compositions that are closer than the prior art applied by the Examiner; thus, the results are particularly significant. Indeed, MPEP § 716.02(e) explains that an applicant may compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the Examiner. As discussed previously on the record, the '704, '862, and '345 patents, relied upon by the Examiner, teach widely varied concentrations and, therefore, ratios of organopolysiloxane to particulate phase. In addition, the '704, '862, and '345 patents teach specific examples having varying compositions and C/B ratios which are far afield from the presently claimed range. In contrast, the testing set forth in the Declaration evaluates comparative Composition 2, which has A/B and C/B ratios

similar to, but falling outside of, the claimed range, and comparative Composition 3, which has a C/B ratio falling within the claimed range, but an A/B ratio falling outside the claimed range. Thus, the Declaration is viable and probative evidence of the non-obviousness of the claimed invention.

As set forth in the Declaration, inventive Compositions 1 and 4 exhibit a pulverulent-to-pasty texture described, for example, in paragraph [007], bridging pages 1 and 2 of the instant specification. Furthermore, Compositions 1 and 4 have a sufficiently elastic and deformable character such that they are “capable of being shaped by pressing . . . practically without expressing the liquid contained the in composition, *i.e.*, practically without exudation.” Instant specification at paragraph [017], page 4. Moreover, Compositions 1 and 4 are “sufficiently solid to be left, in a cylindrical shape . . . at ambient atmospheric pressure . . . and at room temperature . . . without changing shape for [at least] one hour.” *Id.* at paragraph [018], bridging pages 4 and 5. Finally, in light of these results, Compositions 1 and 4 “exhibit good cohesion and can be easily used as make-up.” *Id.* at paragraph [015], page 4. Accordingly, inventive Compositions 1 and 4 satisfy the goals laid out in the instant application, in terms of improved texture, deformability, and cohesion.

In sharp contrast, comparative Compositions 2 and 3, both fail to meet any of the goals set forth in the instant specification. Specifically, both Compositions 2 and 3 had crumbly, powdery textures and were unable to maintain their shape upon exiting the extruder or for any length of time thereafter. In addition, Compositions 2 and 3 were fragile powders, showing poor cohesion and deformability. The results for comparative

Composition 3 are particularly noteworthy since this composition has a C/B ratio falling within the claimed range, but an A/B ratio falling outside the claimed range.

The results set forth in the Declaration are not suggested by the '704, '862, and '345 patents relied upon by the Examiner mainly because the improvements clearly arise from the specific combination of the claimed A/B and C/B ratios. The '704, '862, and '345 patents simply fail to suggest that a pulverulent-to-pasty texture can be achieved by the A/B and C/B ratios recited in the claims. Because one skilled in the art would not have had a reasonable expectation of these improved results, the Declaration supports Applicants' position that the claimed invention would not have been obvious. Accordingly, in view of the foregoing arguments and the Declaration submitted herewith, Applicants respectfully request that the rejections over the '704, '862, and '345 patents be withdrawn.

EP '930 and JP '717

The Examiner relies on the disclosure of the '345 patent as a translation of EP '930. Office Action at 13. As discussed above, the '345 patent does not disclose the claimed A/B and C/B ratios and, in fact, teaches away from the claimed invention. Furthermore, as set forth above, the Declaration of Marie-Laure DELACOUR submitted herewith shows that compositions having the claimed A/B and C/B ratios exhibit improved texture, cohesion, and deformability, such that it would not be obvious to modify the disclosure of the '345 patent to arrive at the present invention. EP '930 is likewise silent with respect to the claimed A/B and C/B ratios and goes no further than the '345 patent in establishing a *prima facie* case of obviousness. For at least this reason, Applicants respectfully request that the rejection over EP '930 be withdrawn.

The Examiner asserts that JP '717 teaches a solid cosmetic composition comprising from 0.1 to 50% by weight of organopolysiloxane. See Office Action at 14. The Examiner admits that JP '717 "fails to teach the claimed particulate phase B in the composition and the additional components . . . of the instant claims" and relies on EP '930 to remedy the deficiencies of JP '717. *Id.* at 15. The Examiner argues that it would have been obvious to include the cosmetic additives of EP '930 in the composition of JP '717 because both references are directed to the same type of cosmetic compositions. See *id.* With respect to the claimed ratios, the Examiner again relies on the disclosure of EP '930 for motivation to optimize the amounts of organopolysiloxane and particulate materials to achieve the claimed invention. See *id.*

As discussed above, EP '930 fails to teach the claimed A/B and C/B ratios and fails to provide a reasonable expectation of success in achieving the improved results, *i.e.*, the improved texture, cohesion, and deformability, of the claimed invention. JP '717, which is silent not only with respect to the claimed ratios, but also completely fails to mention a particulate phase B, goes no further than EP '930 in establishing a *prima facie* case of obviousness. For at least this reason, Applicants respectfully request that the rejection over JP '717 in view of EP '930 be withdrawn.

III. Obviousness-Type Double Patenting Rejection

Claims 1-63 remain rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-63 of the '345 patent. See Office Action at 3.

The Examiner concedes that the '345 patent does not teach the ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to

optimize the compositions of the '345 patent to achieve the present invention. See *id.*

Applicants respectfully traverse the rejection for at least the following reasons.

According to MPEP § 804 II.B.1., an obviousness-type double patenting rejection employs similar guidelines to those used for a statutory obviousness rejection under 35 U.S.C. § 103, except that only the claims themselves are analyzed and the disclosure of the cited patent or application may not be used as the basis of the rejection. Because the '345 patent was filed before the instant application was filed, the "one-way" test of obviousness is used to determine "whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim" in the '862 patent. See MPEP § 804 II.B.1.(a) (*citing In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that claims 1-63 of this application are not obvious over claims 1-63 of the '345 patent.

Specifically, under the one-way test for obviousness of *Berg*, to make a proper obviousness-type double patenting rejection, the Office must show that the presently claimed invention is an obvious variation of the invention claimed in the '345 patent. To establish a *prima facie* case of obviousness, the Office must show that the claims of the '345 patent teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would have been led to modify the prior art to arrive at the presently claimed invention. See MPEP §§ 2143 and 804 II.B.1. The Office has failed to satisfy these requirements in this rejection.

The Examiner admits that "the patented claims do not recite the exact ratios of the instant claims." Office Action at 3. Applicants assert that the '345 patent would not

lead one skilled in the art to modify its compositions to arrive at the presently claimed invention. Specifically, as discussed above with respect to the rejections under § 103, the present invention relates to compositions having a pulverulent-to-pasty texture, which is imparted by the claimed A/B and C/B ratios. In contrast, the '345 patent provides no guidance with respect to the desirability of a composition of this texture, nor the A/B and C/B ratios required to achieve such a texture. Furthermore, the Declaration submitted herewith evidences that a skilled artisan could not have had a reasonable expectation of success in modifying the composition of the '345 patent to arrive at the presently claimed invention. Accordingly, this rejection is improper and Applicants respectfully request that the rejection be withdrawn.

IV. Conclusion

In view of the foregoing amendment and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: _____
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